

In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 919

HAZELTINE RESEARCH, INC., ET AL., PETITIONERS

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

**ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA
CIRCUIT**

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The district court's opinion (Pet. App. 3a-8a)¹ is reported at 226 F. Supp. 459. The opinion of the Court of Appeals for the District of Columbia Circuit (Pet. App. 1a-2a) is not yet reported.

JURISDICTION

The judgment of the Court of Appeals was entered on November 25, 1964 (R. 84). The petition for a writ of certiorari was filed on February 18, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

¹"Pet. App." refers to the appendix to the petition; "Pet." refers to the petition; and "R." refers to the record filed in this Court.

QUESTION PRESENTED

Whether "co-pending patents" constitute a part of the "prior art", within the meaning of that term, as used in 35 U.S.C. 103.

STATUTE INVOLVED

Section 103 of Title 35 provides:

Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

STATEMENT

Petitioner, Robert Regis, filed an application for a patent on a microwave switch on December 23, 1957 (R. 9-15). Three days before, he had assigned all interests in his invention and the application to Hazeltine Research, Inc., the other petitioner in this proceeding (R. 47). On June 24, 1959, the patent examiner denied the application on the ground that the claims set forth therein were "unpatentable over" the Wallace patent, No. 2,822,526, "in view of" the Carlson patent, No. 2,491,644 (R. 23). In terms of the language of Section 103 of the patent statute, the

petitioner's application was held not to have revealed a significant advance over "the prior art."

The Wallace patent was a "co-pending patent"; that is, it had been applied for prior to petitioner's application but had not been issued until after petitioner's application.² The examiner rejected petitioner's argument that a "co-pending patent" was an improper reference to determine the state of "prior art" (R. 23a), and, on March 28, 1962, the Board of Appeals of the Patent Office affirmed the examiner's decision (Pet. App. 9a-12a).

Petitioners then instituted this action in the district court, pursuant to 35 U.S.C. 145, seeking review of the adverse administrative determination (R. 1-5). On February 14, 1964, the district court dismissed petitioners' complaint (R. 75). The court stated that "the sole issue" before it was "whether the Wallace, et al. patent is 'prior art' within the meaning of that term as used in 35 U.S.C. 103." It held that "co-pending patents" were "included in the 'prior art', as that term is used in 35 U.S.C. 103," basing its decision both upon the legislative history of the 1952 Act and upon the fact that prior to the enactment of the 1952 Act a "co-pending patent" could be used as evidence to show that claims are unpatentable (Pet. App.

² In this case, the Wallace application was filed on March 24, 1954; the Regis application was filed on December 28, 1957; and the Wallace application matured into a patent on February 4, 1958 (Pet. App. 4a).

³ Petitioners conceded that if the Wallace patent was a part of "prior art" within the meaning of 35 U.S.C. 103, then the combination of Wallace with Carlson would negate the patentability of their claims (Pet. App. 3a).

5a-8a). The Court of Appeals for the District of Columbia Circuit affirmed, *per curiam* (Pet. App. 1a-2a).

ARGUMENT

The decision of the court below is correct. While the court's holding appears inconsistent with dicta expressed by several other appellate courts, there is no conflict with the holding of any other court of appeals. We do not believe that the question presented in this case is of sufficient importance to warrant further review by this Court in the absence of a true conflict of decisions.

1. Section 103 of Title 35 was enacted as a part of the Act of July 19, 1952, P.L. 593, 66 Stat. 792, which codified Title 35 of the United States Code. That section provides, in pertinent part, that "[a] patent may not be obtained though the invention is not identically disclosed or described * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *." In the instant case, the courts have held that the term "prior art," as used in 35 U.S.C. 103, is not limited to what petitioners knew or could have known; it includes the Wallace patent, which was filed before, but issued after, petitioners' patent application. In other words, "co-pending patents" were held to be a part of the "prior art" and thus available as references for the purposes of determining the patentability of a particular invention.

We believe that this holding is correct. Prior to the 1952 Act, this Court stated, in holding a patent invalid for want of an invention over the prior art, that "co-pending patents" could be used to establish the state of the prior art. *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259. In particular, the Court sustained the defendant's argument that the subject of the infringement proceeding [the Wheeler patent] "involved no invention in view of the prior art," holding that "patents issued before Wheeler's date of conception and others issued before the patent in suit on applications antedating his date of invention and pending when his application was filed * * *. All constituted prior art." 313 U.S. at 265. See also *Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390; *Sherwin-Williams Co. v. Marzall*, 190 F. 2d 606 (C.A. D.C.); *application of Seid*, 161 F. 2d 229 (C.C.P.A.). Moreover, the decisions of the courts below are in complete accord with the construction given the phrase "prior art" in Section 103 of the 1952 Act by the Court of Customs and Patent Appeals, the tribunal which regularly hears and determines patent cases. See, e.g., *Application of Harry*, 333 F. 2d 920; *Application of Kander*, 312 F. 2d 834; *Application of Gregg*, 244 F. 2d 316. Finally, the legislative history of Section 103 appears to support the view expressed by both the Court of Customs and Patent Appeals⁴ and by the court below (Pet. App. 7a) that

⁴The Court of Customs and Patent Appeals has stated that "the legislative history of the 1952 Act makes it clear that 'co-pending patents' were intended to be part of the 'prior art.'" *Application of Harry*, *supra*, at p. 923, n. 1.

Congress intended "co-pending patents" to be a part of the "prior art." See S. Rep. No. 1979, 82d Cong., 2d Sess., pp. 5-6; H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7; see also Senate Subcommittee on Patents, Trademarks and Copyrights, *Efforts to Establish a Statutory Standard of Invention*, Study No. 7, 85th Cong., 1st Sess., p. 15; Hearings before Subcommittee No. 3 of the House Committee on the Judiciary on H.R. 3760, 82d Cong., 1st Sess., p. 221.

2. Petitioners contend that the holding of the court of appeals in the instant case is in conflict with *Weatherhead Co. v. Drillmaster Supply Co.*, 227 F. 2d 98 (C.A. 7); *Helene Curtis Industries v. Sales Affiliates*, 233 F. 2d 148 (C.A. 2), certiorari denied, 352 U.S. 879; and *John Blue Company v. Dempster Mill Mfg. Co.*, 275 F. 2d 668 (C.A. 8) (Pet. 12-16). While there are statements in each of these cases which appear inconsistent with the holding below, in each case the claim of the patent-holder was rejected and the patent held invalid on an alternative ground. The statements do indicate that those circuits have or have had a view inconsistent with that of the District of Columbia Circuit, but they do not amount to holdings in conflict with the decision below, and we do not believe that the question presented in this case is of such general importance as to warrant further review by this Court when there is no real conflict of decisions. Finally, we note that the other decisions relied upon by the petitioners on pages 13 and 14 of the petition all involve cases decided prior to the enactment of Section 103 in 1952 and are thus not constructions of the provision here under review.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted.

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